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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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Signature _____

Typed or printed name _____

Application Number

10/035,584

Filed

12/28/2001

First Named Inventor

Guy L. Steele, JR

Art Unit

2193

Examiner

Chat C Do

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 56,249

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Nathan A Sloan
Signature

Nathan A Sloan
Typed or printed name

202.408.4312
Telephone number

9/30/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT

Customer No. 22,852
Attorney Docket No. 06502.0366-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Guy L. STEELE, Jr.)	Group Art Unit: 2193
)	
Application No.: 10/035,584)	Examiner: Do, Chat C.
)	
Filed: December 28, 2001)	Confirmation No.: 2869
)	
For: FLOATING POINT REMAINDER)	
WITH EMBEDDED STATUS)	
INFORMATION)	

Mail Stop AF

Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Actions mailed on May 5, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed July 14, 2005.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-37 remain pending, with claims 1-37 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-37 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,995,991 to Huang et al. ("*Huang*") in view of U.S. Patent No. 5,065,352 to Nakano ("*Nakano*"); and rejected claims 1-37 under obviousness-type double patenting as being unpatentable over claims 1-37 in copending Application No. 10/035,580 ("*580*") in view of U.S. Patent No. 5,065,352 to Nakano ("*Nakano*").¹

I. The rejection of claims 1-37 under 35 U.S.C. § 103(a) as being obvious over *Huang* in view of *Nakano* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to claims 1-37 based on *Huang* in view of *Nakano*. Neither *Huang* nor *Nakano*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claim 1 recites a combination including, for example,

an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand based upon an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand based upon data within the first floating point operand and data within the second floating point operand respectively; and

a results circuit coupled to the analyzer circuit and configured to assert a resulting floating point operand containing the remainder of the first floating point operand and the second floating point operand and a resulting status embedded with the resulting floating point operand

(emphasis added).

¹ Pending the withdrawal of the rejection under 35 U.S.C. § 103(a), Applicant will respond to the double patenting rejection as set forth in M.P.E.P. § 804(I)(B) or § 804.02. Applicant does not request review of this rejection by the Pre-Appeal Brief review board.

The Examiner appears to assert that *Huang's* register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

Huang specifically distinguishes between a register and an operand, stating "each of the **registers** 116 and 118 has an **operand . . . portion** 116-1 and 118-1." (*Huang*, col. 6, line 66-col. 7, line 1). Moreover, "**operands** X and Y [are] stored in **operand portions** 116-1 and 118-1 of **registers** 116 and 118." (*Huang*, col. 7, lines 8-10). Even assuming that tag values x_tag and y_tag correspond to the claimed "data" and "status," (which Applicant does not concede) the Examiner's contention that *Huang's* register 116 containing x_tag 116-2 constitutes the claimed "data within the ... operand" or "status embedded with the ... operand" is clearly contradicted by *Huang*. See, e.g., *Request for Reconsideration "RFR"* at pp. 3-4.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant's specification, which states "conditions are typically represented by flags [a form of status] that are stored in the floating point status register" (paragraph 025, see also paragraph 03). Claim 1 specifically distinguishes over such structures, calling for data within the ... operand" and a "status embedded with the ... operand." See, e.g., Fig. 2 and paragraph 044 Applicant's specification.

Accordingly, the Examiner's position that *Huang's* register 116 constitutes an "operand," as recited in the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 do not constitute a teaching or suggestion of "data within the ... operand" or a "status embedded with the ... operand," as recited by independent claims 1, 14, 26 and required by dependent claims 2-13, 15-25, and 27-37.

Moreover, *Nakano* fails to cure the deficiencies of *Huang*, nor does the Examiner rely on *Nakano* for "data within the ... operand" or a "status embedded with the ... operand." See *RFR* at p. 5, *Advisory Action* at p. 2.


Since *Huang* and *Nakano*, taken alone or in combination, fail to teach or suggest each and every element of the claims, the rejection of claims 1-37 under 35 U.S.C. § 103(a) is improper. Applicant requests that the board of examiner withdraw the rejection.

In view of the foregoing, claims 1-37 are in condition for allowance, pending withdrawal of the double patenting rejection. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: 
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